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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/741,793	12/19/2003	Alan E. Hairsine	32210.20.0	5589
22859 7590 09/03/2008 INTELLECTUAL PROPERTY GROUP FREDRIKSON & BYRON, P.A. 200 SOUTH SIXTH STREET SUITE 4000 MINNEAPOLIS, MN 55402				
EXAMINER WEIER, ANTHONY J				
ART UNIT		PAPER NUMBER		
1794				
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09/03/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/741,793

**Applicant(s)**

HAIRSINE ET AL.

**Examiner**

Anthony Weier

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 12-14, 18-21, 24-68 and 71-79 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 19, 27-54, 57 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 12-14, 18, 20, 21, 24-26, 55, 56, 59-68, and 71-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. This application contains claims drawn to an invention nonelected with traverse in the reply filed on 2/20/07. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 12-14, 18, 20, 21, 24-26, 59-68, and 71-79 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification does not appear to provide support for the recitation that "the orifice is sized to spread the yolk to create the look of a fried egg having a broken yolk" (e.g. claim 1). Rather, support exists for the mold itself providing a product resembling a grilled cooked fried egg (e.g. paragraphs 38 and 39). The only apparent support for the use of the term "spread" involves the removal of the cracked egg shell (paragraph 62).

***Claim Rejections - 35 USC § 112, 2nd paragraph***

- 3 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 12-14, 18, 20, 21, 24-26, 59-68, and 71-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 and elsewhere, the terminology of "the orifice ...sized to spread the yolk to create the look of a fried egg having a broken yolk" is indefinite in that it is not clear as to how the orifice itself causes the so-called spread. Moreover, it is not clear as to what is encompassed by the terminology "fried egg" as same could be an egg fried over hard or even an omelet.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 55 and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimizu.

Shimizu (cols. 2 and 3) discloses a process wherein eggs are mechanically and automatically conveyed (e.g. col. 1, lines 51-55; col. 2, lines 8-13; col. 3, line 30- col. 4, line 8) and subjected to breaking with cutters (8; i.e. knives) wherein the contents of same (including yolks) are deposited into a plurality of molds (each having a

symmetrical and rounded outline) all connected (the outer molds providing a closed loop of the plurality) wherein said molds have a first depression with a second depression disposed inside the first (thus providing an irregular shaped bottom surface for the molding said eggs), said yolk being allowed to settle in the second depression having a rounded region (e.g. 13c), said eggs then being cooked after moving said molds to a heating area, and said eggs being cooled (e.g. frozen). In order to package, consumer same, etc., it is inherent that said eggs would be removed from the molds as also called for in claim 55.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 55 and 56 are rejected under 35 USC 103(a) as being unpatentable over Dunckel taken together with any one of Davis, Glasser et al, and Shimizu.

Dunckel discloses a process wherein eggs are mechanically and automatically conveyed and subjected to breaking with knives (92) wherein the contents of same (including yolks) are deposited into a plurality of molds (each having a symmetrical shape) all connected, said eggs then being cooked after moving said molds to a heating area, and said eggs being removed from said pans, and subsequently cooled. Dunckel further discloses an embodiment wherein the yolks are broken through mixing to create a scrambled egg mixture that is deposited in the molds (cols. 2-4; Figures).

The claims further call for said mold to comprise a first depression and a second depression within said first. However, such molds for eggs are notoriously well known to aid in providing demarcation between the yolk and white portions as taught, for example, in any one of Davis, Glasser et al, and Shimizu. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included same to provide a product having a particular desired aesthetic (uniformity, shape, color distribution, etc.)

8. Claims 1, 2, 12-14, 21, 59-62, 64, 65, 67, 68, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stearns et al taken together with WO 87/03171.

Stearns et al (e.g. Fig. 2; cols 2 and 3) discloses a process wherein the contents eggs (yolks previously broken) are deposited into a plurality of molds (e.g. irregular shaped) wherein said molds are arranged side by side as called for in claim 12, said eggs then being cooked in said molds, and subsequently cooled (e.g. frozen). It should be noted that the egg yolks would inherently be ruptured when falling through a propeller type mixer wherein it is considered expected that the propellers have sharp edges and are contained within an orifice area of the mixer (Example 1).

The claims further call for the eggs being dropped through a plate having sharp inwardly protruding edges. WO 87/03171 teaches a method of breaking egg yolk sacs using pins (e.g. 100) which are sharp and inwardly protruding. It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated such yolk breaking step in order to facilitate easier subsequent mixing of

yolks and whites. It should be noted that if the rupturing means of pins are not considered to be inwardly protruding edges, WO 87/03171 further discloses the use of equivalent means to achieve such purpose, and clearly the use of sharp knives or other protruding cutters would provide the same rupturing action.

The claims further call for the use of plural edges within a single plate. However, absent a showing of unexpected results, it would have been further obvious to have increased the number of such pins to increase the number of ruptures as a result effective variable.

9. Claims 1, 2, 12-14, 18, 20, 59-68, 71-73, and 75-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu taken together with WO 87/03171 and further in view of any one of Stearns et al, Stier, and Matter.

The claims further call for said molds to be irregularly shaped. However, it is well known to provide irregularly shaped molds for preparing eggs as set forth in Stearns et al (col. 3, lines 1-19), Stier (see Figures), and Matter (see Figures). It would have been obvious to one having ordinary skill in the art at the time of the invention to have provided such shaping molds as a matter of preference with regard to the desired aesthetics of the final product.

The claims further call for the depression of the mold being asymmetric. However, such modification in shape would have been further obvious as a matter of preference with regard to the desired aesthetics of the final product.

The claims further call for the eggs being dropped through a plate having sharp inwardly protruding edges. WO 87/03171 teaches a method of breaking egg yolk sacs

using pins (e.g. 100) which are sharp and inwardly protruding. It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated such yolk breaking step to provide for better distribution of the yolk and egg white in the molds of Shimizu. In other words, without providing the rupture of the yolk sac, it is expected that there would be instances where the yolk sac would bridge two mold depressions. By breaking the yolk sac, the yolk and white would be free to better separate between the two mold depressions. It should be noted that if the rupturing means of pins are not considered to be inwardly protruding edges, WO 87/03171 further discloses the use of equivalent means to achieve such purpose, and clearly the use of sharp knives or other protruding cutters would provide the same rupturing action.

The claims further call for the use of plural edges within a single plate. However, absent a showing of unexpected results, it would have been further obvious to have increased the number of such pins to increase the number of ruptures as a result effective variable.

It should be noted that Shimizu further discloses molds that have flat bottom depressions and beveled edges surrounding said depressions as called for in claims 76 and 77 (see Fig. 2).

10. Claim 74 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu taken together with WO 87/03171 and Beale et al and further in view of any one of Stearns et al, Stier, and Matter.



Claim 74 further calls for said mold to have a planar surface that is formed of a non-stick, food grade material. However, it is notoriously well known to provide cooking utensils having such attributes as taught, for example, by Beale et al (e.g. Abstract). it would have been obvious to one having ordinary skill in the art at the time of the invention to have employed same in the mold of Shimizu to provide easier removal of the molded food article and to ensure that the coating material itself is consumably safe if particles of same should fall into the food product.

11. Claim 21 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 87/03171.

WO 87/03171 discloses a process wherein egg yolks and whites from cracked eggs are dropped into a device wherein said device comprises multiple orifices (for each egg; e.g. claim 28) having sharp inwardly protruding edges (via the pin 100 or its equivalent, page 12) which rupture the egg yolk sacs (e.g. Figure 10D).

The claims further call for the eggs being dropped through a plate having sharp inwardly protruding edges. WO 87/03171 teaches a method of breaking egg yolk sacs using pins (e.g. 100) which are sharp and inwardly protruding. It should be noted that if the rupturing means of pins are not considered to be inwardly protruding edges, WO 87/03171 further discloses the use of equivalent means to achieve such purpose, and clearly the use of sharp knives or other protruding cutters would provide the same rupturing action.

The claim further calls for the use of plural edges within a single plate. However, absent a showing of unexpected results, it would have been further obvious to have

increased the number of such pins to increase the number of ruptures as a result effective variable.

### ***Applicant's Arguments***

12. Applicant's arguments filed 6/30/08 have been fully considered but they are not persuasive.

Applicant argues that the molds of Shimizu, Glasser et al, and Davis do no have a first depression with a second depression therein, said second depression having a rounded region. Examiner disagrees. In fig. 3 of Shimizu, 13c is the 2nd depression wherein same contains a rounded region (albeit the whole depression being rounded). The first depression is considered the other portion of the mold of 13 including the surrounding walls and depression floor 13a. Davis has a similar mold wherein a first depression (5 of Figures 2-4) contains a second depression therein (3 of Figures 2-4) wherein the second depression has a rounded region (e.g. projection 1 and floor 3 provides rounding). Likewise, Glasser et al discloses a mold (Figure 2) having a first depression (4) with a second depression therein (3), said second depression having a rounded region (albeit most of the second depression being rounded).

Applicant argues that Dunckel does not teach mold shapes. Examiner disagrees. The pans used (28) each have cavities which inherently mold the egg product during cooking. In addition, Figure 4 shows a suggested square overview shape of a pan.

Applicant argues that the prior art does not disclose or suggest varying the thickness of the product as well as providing a distinct egg yolk portion. However, the

instant claims do not call for such varied thickness. Nevertheless, the molds of Davis, Shimizu, and Glasser et al clearly teach a product formed after molding that would possess a varied thickness as a whole (i.e. thickness is not uniform in Figs. 1-4 of Davis, Fig. 2 of Glasser et al, and Fig. 3 of Shimizu).

Applicant argues that WO 87/03171 teaches breaking of a yolk which has been separated from egg white wherein the yolk and the white are not dropped through the apparatus of WO 87/03171 and wherein said apparatus does not provide an orifice sized to spread the yolk to create the look of a fried egg having a broken yolk. It should be noted, however, that WO 87/03171 was applied with other references to teach the claimed method of yolk breaking. The primary references in each of the rejections that employ WO 87/03171 disclose the deposition of eggs contents into molds for further treatment. It would have been obvious to one having ordinary skill in the art at the time of the invention to have employed the teaching of WO 87/03171 as a means of providing easier mixing of yolk and egg white in the case of Stearns et al and to provide better distribution of separated egg yolk and white in the process of Shimizu as discussed above. Nevertheless, it should be noted that the instant claims do not require that the yolk and white remain together throughout treatment in the apparatus itself. It is expected that any shaped orifice would deliver an egg to a mold where same would naturally spread out. Moreover, the claim requirement that said product have the look of a fried egg would be met whether the egg is mixed as in Stearns or kept whole since the term "fried egg" would naturally encompass a fried yolk, fried egg white, or any fried mixture of same (including a whole fried egg). The primary references Stearns et al

and Shimizu disclose preparation of fried egg products from egg yolk and egg white, and clearly, one having ordinary skill in the art at the time of the invention would have recognized that the yolk breaking technique of WO 87/03171 would be reasonable to apply to the primary references for the reasons set forth above.

All other arguments have been addressed in view of the rejections as set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anthony Weier  
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Anthony Weier  
August 29, 2008